

### **REMARKS**

Claims 14-17 and 27-41, as amended, and new claims 42-48 are pending in this application. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claim 14 has been rewritten to further clarify that the method applies to golf shoes and the particular parameters relating to the selection of golf shoes. In addition, claims 42-48 have been added to recite additional embodiments of the invention, which are fully supported by the Written Description. *See, e.g.*, Page 7, line 34 to Page 8, line 2; Page 8, lines 21-25; and Page 10, lines 7-19. As no new matter has been added, Applicants respectfully request entry of these amendments at this time.

### **THE REJECTIONS UNDER 35 U.S.C. § 103**

Claims 14-17 and 27-41 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent Publication No. 2001/0020222 to Lee or U.S. Patent Publication No. 2002/0158358 to Franzene in view of U.S. Patent No. 5,671,055 to Whittlesey *et al.* for the reasons provided on pages 2-4 of the Office Action.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Young*, 927 F.2d 588,591 (Fed. Cir. 1991). Neither combination of references render obvious the presently recited claims for at least the reasons discussed below.

#### ***The Pending Claims Are Not Obvious Over the Lee/Whittlesey Combination***

Lee is directed to a custom-made footwear manufacturing system that uses foot shape information, style, fashion, and color transmitted via the internet to manufacture shoes. *See, e.g.*, page 3, para. 0054. While Lee's system does allow for selection of parameters in addition to accounting for the foot shape, the parameters suggested relate to the shape, fashion, color, and height of the heel. *See* page 4, para. 0074. As recognized by the Examiner, Lee does not disclose the use of the system for golf shoes and, thus, is completely silent as to the selection of any parameters relating specifically to golf shoes. Office Action at Page 2.

In contrast, the present invention features shoe size, as well as certain parameters relating to golf shoes. For example, independent claim 14 recites first and second parameters selected from the group consisting of cleat type and personalization and traction level and cushioning, respectively. Likewise, the additional parameters featured in independent claims 27 and 35 are the cleat type and custom indicia, respectively. Lee is completely silent as to the use of the system for golf shoes and, thus, the parameters featured in claims 14, 27, and 35 are not even suggested in the reference.

In an attempt to remedy the deficiencies of Lee with regard to the present invention, the Examiner has cited Whittlesey. However, Whittlesey does not cure the deficiencies of Lee merely through the brief discussion in the background section of the reference regarding the importance of the “fit” relating to golf shoes. In particular, the only mention of golf, golf shoes, and golfers in the entire reference is the following:

Properly fitting shoes are always important to consumers, but fit can be particularly important for consumers such as golfers, who use the relatively stiff golf shoes over varied terrain, for relatively long periods of time, and in varied weather conditions. Golfers often experience problems such as blistering caused by poorly fitting golf shoes. Thus, it is desirable to obtain the best fitting shoes to minimize such problems.

Col. 1, lines 20-27. Whittlesey goes on to explain that the foot size and shape can be measured using laser beams to create a three-dimensional profile of the foot and ultimately determine shoe size. Col. 2, lines 35-51. The profile is compared to a database of lasts for a particular shoe style in order to select a shoe that “fits”. Col. 10, lines 36-41. Custom shoe lasts may also be determined based on the profile. Col. 11, lines 18-19.

Whittlesey is completely silent as to golf shoe parameters outside of pure size characteristics. In fact, there is no mention whatsoever of traction level, cleat type, personalization, or cushioning. As such, a skilled artisan would have lacked any motivation to arrive at the present invention based on the combination of Lee and Whittlesey absent the instant application to use as a template, which is a classic case of impermissible hindsight. Even assuming, *arguendo*, that “fit” characteristics included an assessment of cushioning or traction level, a skilled artisan would not have been motivated to consider cleat type or personalization based on a concern for potential blistering.

With regard to new claims 46-48, the combination of references is also completely silent as to the ability of translating the parameters entered by the user into manufacturing control data as recited in the claims. In fact, the disclosures of Lee and Whittlesey are similar to other conventional processes in that there is typically human involvement in the process, *i.e.*, the information sent over the internet is received and reviewed by an operator who then must program the machinery to form a product based on the specifications.

Therefore, Applicants respectfully submit that the combination of Lee and Whittlesey does not disclose or suggest the present invention. Applicants respectfully request reconsideration and withdrawal of the § 103 rejection based thereon.

*The Combination of Franzene and Whittlesey Do Not Disclose or Suggest the Present Invention*

Franzene generally discloses a method of measuring a foot, creating a foot profile, transmitting the foot profile to a manufacturing station, and creating a foot mold, *i.e.*, an insole, from the foot profile. *See, e.g.*, page 2 at para. 0041. While the disclosure does teach a method for forming a custom insole to be used directly as a sandal, shoe sole, or within a shoe structure, Franzene is completely silent as to the use of the method for soliciting or placing an order for golf shoes, as presently recited. As such, it follows that Franzene is also completely silent as to the features of the claimed invention that are specific to golf shoes, *i.e.*, cleat type. In fact, Franzene's method does not include any shoe parameters outside of the size, shape, contour, or other parameters required to make a custom insole. *See, e.g.*, page 3 at para. 0056.

Similar to Lee, the Examiner recognizes that Franzene does not disclose a system that accounts for the selection of any parameters relating specifically to golf shoes and, thus, cites Whittlesey as a secondary reference. Office Action at Page 3. Accordingly, for the same reasons as above with Lee, Whittlesey does not remedy the deficiencies of Franzene. For example, Whittlesey is directed to determining the fit of a shoe from a three-dimensional profile. The reference is completely silent as to the parameters presently recited (specific to golf shoes) that are not related to the fit of a shoe. Thus, a skilled artisan would have lacked any motivation to arrive at the present invention (absent the use of impermissible hindsight) based on the mere suggestion by Whittlesey that an improved fit may reduce blistering on a golfer's foot.

Moreover, with regard to new claims 46-48, the Franzene / Whittlesey combination does not disclose or suggest the step of translating the parameters entered by the user into manufacturing

control data as recited in the claims. In fact, there is no suggestion to avoid the human involvement typically present in the process. As such, a skilled artisan would not have been motivated to arrive at the present invention absent the use of hindsight.

In sum, the combination of Franzene and Whittlesey does not render obvious the present invention. Therefore, Applicants respectfully request reconsideration and withdrawal of the § 103 rejection based thereon.

### CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response three months to and including April 12, 2007. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Bingham McCutchen LLP Deposit Account No. 195127, Order No. 20004.0008.

Respectfully submitted,  
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